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10/616,970	07/11/2003	Satoshi Kidooka	P23559	2858

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/616,970	Applicant(s) KIDOOKA, SATOSHI	
	Examiner Peter J. Vrettakos	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim 6 is cancelled.

Claims 1-5 and 7-21 are rejected below. Claims 1 and 19 are independent.

New claims have elicited new and modified rejections. (Note that Marucci jaw/manipulation members are now element 12 – prior rejections the jaw members were element 15).

The action is final.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Specification does not mention powered *movement* of the members.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims depend from claim 1, which disclose a shaft. Claims 16 and 17 disclose that the shaft is two shafts. When the reader considers this, the claims become indefinite with respect to the limitation in claim 1 that reads "manipulation members...pivotally supported by said shaft". The question is, "which shaft?" One of the shafts? Both of the shafts? (The same rationale can be applied to the last limitation in claim 1.) Claims 16 and 17 are hence indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7,9,10, 11, 13-15 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marucci et al. (6,582,451).

Marucci neglects to expressly disclose manipulation members comprising electrodes.

Independent claims 1,19 (parentheticals refer to Marucci)

A treatment tool (see figure 1a – *the rejection relies heavily upon this figure*) to be inserted into a human body through an endoscope (col. 1:20-25) comprising:

an elongated inserting portion (13) to be inserted through an accessory channel of the endoscope;

a supporting member (11) attached to a distal end of said inserting portion, said supporting member being provided with a slit (depicted at 74 in figure 1a);

a shaft (28, better depicted but not enumerated in figure 1c) attached (through the holes adjacent element 74 in figure 1a) to said supporting member so as to cross said slit in a width direction thereof (depicted figure 1b);

a pair of manipulation members (12, 12) at least one of said pair of manipulation members being pivotably supported by said shaft within said slit (depicted in figure 1g, *inter alia*) so as to open and close with respect to another of said pair of manipulation members like a pair of pincers ("jaws"), said pair of manipulation members comprising a pair of electrodes (***see col. 6:33-40 for a disclosure of jaw members and associated modalities strongly related to electrode use such as radiofrequency and unipolar/bipolar electrocautery***); and

a spacer (constituted by elements 24-25) located between said pair of manipulation members,

wherein said shaft (28) is supported by said spacer (24-25) so as not to come off from said supporting member.

19. (New) A treatment tool configured to be inserted into a human body through an endoscope (col. 1:20-25), said treatment tool comprising: an elongated insertion portion configured to be inserted through an accessory channel of the endoscope;

a supporting member (11) attached to a distal end of said inserting portion, said supporting member having a longitudinally extending slit (74);

a shaft (28) attached to said supporting member so as to extend across said slit in a width-wide direction;

a manipulation member (12), pivotally supported (see cross hairs at 28 in figure 3e) by said shaft so as to pivot about said shaft between opened (figure 1e) and closed (figure 1g) positions with respect to another manipulation member; and

a spacer (24-25) fixedly positioned with respect to said supported member within said slit (74), said spacer located between said manipulation member and said another manipulation member (two element 12s) and supporting said shaft (28).

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Marucci by including as a design expedient jaw members (12) comprising electrodes in light of the disclosure in col. 6:33-40 where RF and electrocautery are disclosed. The motivation would be to create a device capable of performing through electrodes its disclosed intended use (RF, electrocautery).

Dependent claims

2. The treatment tool according to claim 1, wherein said shaft (28) is pressed (depicted in figure 1e) into said spacer (24-25). Note the corresponding hole into which element 28 rests is depicted but not enumerated figure 1b).

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3. The treatment tool according to claim 2, wherein said spacer (24-25) is provided with a through hole (depicted and enumerated –28- in figure 1a) having an inner diameter smaller than an outer diameter of said shaft (inherent for shaft to rest securely in through hole), said shaft being pressed (again, inherent) into said through hole.

4. The treatment tool according to claim 1, comprising a pair of said shafts (28 and 26 – figure 1a), both of said shafts being pressed into said spacer (24-25), each of said pair of manipulation members (12) being pivotably mounted to respective one of said shafts so as to open and close like a pair of pincers (“jaws”).

5. The treatment tool according to claim 4, wherein said spacer (24-25) is provided with a pair of through holes (figure 1a, element 28 and the non-enumerated proximal and longitudinally parallel hole) formed in parallel to each other, each of said through holes having an inner diameter smaller than an outer diameter of each of said shafts (26,28) (inherent for shaft to rest securely in through hole), said shafts being pressed (again, inherent) into respective one of said through holes.

7. The treatment tool according to claim 6, wherein said spacer is made of poly-tetra-fluoro-ethylene. See col. 12:35-41. The disclosure of atraumatic plastic anticipates poly-tetra-fluoro-ethylene, an atraumatic plastic.

9. The treatment tool according to claim 6, wherein said manipulation members (12; "jaws") are connectable to a high frequency power supply. See col. 6:33-40 for a disclosure of jaw members and associated modalities strongly related to connections to high frequency power supplies such as unipolar/bipolar electrocautery.

10. The treatment tool according to claim 1, wherein said supporting member (11) is made of insulating material. See col. 12:35-41 – plastic = insulating material.

11. The treatment tool according to claim 10, wherein said supporting member (11) is made of rigid plastic. See col. 12:35-41.

13. (New) The treatment tool according to claim 1, wherein said shaft (28) engages said supporting member (11), said spacer (24,25) and one of said manipulation members (12). See figure 1g.

14. (New) The treatment tool according to claim 1, wherein said pair of manipulation members are configured to rotate (see cross hairs at 28 in figure 3e inferring pivot/rotation) about said shaft.

15. (New) The treatment tool according to claim 1, wherein said spacer is fixedly positioned with respect to said supporting member. Addressed below in Response to Arguments section.

20. (New) The treatment tool according to claim 19, said manipulation member and said another manipulation member comprising conductive electrodes. Addressed above in part of rejection toward claim 1.

Claims 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marucci et al. in view of Mayenberger (5,853,412).

Marucci is silent concerning ceramics.

Mayenberger discloses in an invention analogous to Marucci, ceramic parts (insulating by design). See Mayenberger claims 5 and 8.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Marucci in view of Mayenberger by including as a design expedient ceramic parts for their insulating properties (motivation) as disclosed in Mayenberger.

Response to Arguments

Applicant's arguments filed 9-22-05 have been fully considered but they are not persuasive. Applicant argues that Marucci jaw members/manipulation members are platforms for electrodes and as a result do not "comprise" electrodes. In response the Office directs the reader to MPEP 2111.03 [R-3] regarding the word, "comprising". Case

law evinces that “comprising” is open-ended and “does not exclude additional, unrecited elements.” To this end, Marucci disclosing in col. 6:33-40 that jaw members are platforms for electrodes does not invalidate the Examiner’s designation that Marucci’s jaw members are comprised of electrodes. (The Office contends that jaw members acting as platforms for electrodes (with electrodes included in the description) is equivalent to jaw members comprised of electrodes, and implicitly additional, unrecited elements such as a platform.)

Next, the Applicant argues that the Marucci spacer (24-25) is not necessarily disclosed as insulating (as would be implied by disclosure of “atraumatic plastic”). The Applicant refers to col. 12:36-41 and mentions that this broad disclosure is merely an invitation to invent. The Office has in response changed the prior Marucci 35 USC § 102 rejection to a 35 USC §103 rejection. The disclosure in col. 12:36-41 is broad, however, the Office strongly asserts that because the disclosure only permits a limited number of variations one of ordinary skill in the art would deduce from that disclosure that the Marucci spacer could be made of plastic (hence insulating) and that any benefits would be determined through routine experimentation.

Also, the Applicant argues that the Marucci jaws (12) do not pivot about the shaft (28). The Office responds that the jaws (12) in fig. 1e (open position) and then fig. 1g (closed position) do indeed pivot around shaft (28) *through linkage 25*. See the cross hairs in figure 1g at element 28 inferring a pivot point.

The Applicant argues that the Marucci spacer (24-25) is not fixedly positioned with respect to the support member (11). The Office respectfully disagrees. Figure 1a

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shows a distal hole in support member (11) through which the spacer (24-25) is fixedly positioned with respect to the support member by shaft 28. (The spacer's articulation in space does not preclude this designation/apprehension.)

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

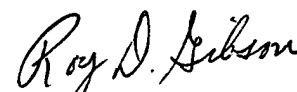
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
December 21, 2005




ROY D. GIBSON
PRIMARY EXAMINER